

### Remarks

This is in response to the second non-final Office Action mailed March 23, 2006, which rejected claims 1-3, 6-7, 10-12, 14, 17-18, 20-21 and 23-25, and objected to claims 4, 5, 15, 16, 19 and 22. Reconsideration of this non-final rejection is respectfully requested.

### Rejection of Claims Under 35 U.S.C. §103(a)

Claims 1-3, 6-7, 10-12, 14, 18, 20-21 and 23-25 were rejected as obvious over U.S. Patent No. 5,818,658 to Balster et al. ("Balster '658") in view of U.S. Patent No. 6,369,978 to Shimizu et al. ("Shimizu '978"). Claim 17 was rejected as obvious over these references, further in view of U.S. Patent No. 6,259,576 to Ahn ("Ahn '576"). These rejections are respectfully traversed.

The Examiner has suggested that one skilled in the art would be motivated to place the flow device nozzle 24 of Balster '658 adjacent the downstream space 11 of Shimizu '978 in order to "reduce flutter and turbulence and prevent additional pressure fluctuation [on the] upstream and downstream sides." (Office Action, page 3, lines 1-2). This is respectfully traversed.

In determining obviousness, "the inquiry is not whether each element existed in the prior art, but rather whether the prior art made obvious the invention as a whole for which patentability is claimed." *Hartness International, Inc. v. Simplimatic Engineering Co.*, 2 USPQ2d 1826, 1832 (Fed. Cir. 1987).

In the present case, there is nothing to motivate one skilled in the art to combine the teachings and suggestions of the cited references, as suggested by the Examiner, to arrive at the claimed combination. *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999)(evidence for

motivation to combine must be “clear and particular”). Since motivation to combine is lacking, the Applicant respectfully submits that the rejection is based on improper hindsight reconstruction of the claims, and hence improper. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002)

Shimizu ‘978 teaches to reduce pressure fluctuations across a transducer 5 by using a bypass channel 15 which controllably directs a portion of an upstream airflow from an upstream shroud opening 12c to the downstream space 11. Col. 6, lines 4-7; col. 6, lines 27-30; FIGS. 1-2 and 4-5. Shimizu ‘978 thus recognizes a problem of pressure fluctuations, but provides its own solution via the bypass channel 15. It is well settled that merely showing appreciation for the problem solved, without teaching the claimed solution, is insufficient to establish motivation. *Group One, Ltd. v. Hallmark Cards, Inc.*, 407 F.3d 1297 (Fed. Cir. 2005).

Balster ‘658 teaches a fly height tester that uses nozzle 24 to adjust the fly height of transducer 14. The nozzle 24 is located *over* the flexure arm 18 to generate a sub-ambient pressure region to draw the transducer 14 *up or down* (elevationally) with respect to a medium 22. See Applicant’s Previous Response filed January 12, 2006, page 10, lines 7-13 and page 11, lines 6-9; Balster ‘658, col. 3, lines 27-40 and FIG. 2.

Balster ‘658 explicitly directs the flow evenly to *both sides* of the flexure arm 18 to avoid introducing an undesired angle (slider translation) of the transducer as the transducer is raised or lowered. Balster ‘658, col. 1, lines 50-58; col. 3, lines 46-53. Balster ‘658 thus expressly *teaches away* from the claimed combination, as Balster ‘658 requires the pressure to be applied by the nozzle 24 to both sides of the flexure arm 18. Movement of the nozzle to one side of the transducer, as suggested by the Examiner, would wholly defeat the

purpose of Balster '658. *Syntex (U.S.A.) LLC v. Apotex, Inc.*, 407 F.3d 1371 (Fed. Cir. 2005).

The Applicant respectfully submits that one skilled in the art would not be motivated to combine the respective Balster '658 and Shimizu '978 references in the manner suggested by the Examiner. Rather, the Examiner has improperly used the present claims as a blueprint to pick and choose elements from the respective references to assemble the claimed combination without regard to the actual teachings and suggestions of the respective references. This is insufficient to establish a prima facie case of obviousness. *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809 (1986).

Reconsideration and withdrawal of the rejection of claim 1, and for the claims depending therefrom, are respectfully requested on these bases. As the cited references are similarly deficient with regard to independent claims 10 and 20, reconsideration and withdrawal of the rejection of these claims, and for the claims depending therefrom, are also requested.

#### **Allowable Subject Matter**

The Applicant gratefully acknowledges the indication of allowability of dependent claims 4, 5, 15, 16, 19 and 22.

#### **Conclusion**

The Applicant respectfully requests reconsideration and allowance of all of the claims pending in the application. This Response is intended to be a complete response to the first Office Action mailed March 23, 2006.

Should any questions arise concerning this response, the Examiner is invited to contact the below signed Attorney.

Respectfully submitted,

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